

## REMARKS

Upon entry of the present amendment, claims 1-23 will be pending in the application.

Claim 1 has been amended for clarity. No new matter has been introduced by this amendment.

No claims have been added, or canceled.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. Rejection of claims 1-3, 6-12, 14-15, and 17-23 under 35 U.S.C. §102(b) as allegedly anticipated by, or, in the alternative, under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,633,037 to Mayer, hereafter "Mayer".

Independent claim 1 is directed to a process for overcoating a multicoat color and/or effect paint system, wherein the multicoat color and/or effect paint system comprises at least one color and/or effect basecoat (A) produced from at least one aqueous basecoat material (A) and at least one clearcoat (B) produced from at least one liquid clearcoat material (B), the process comprising, among others, (1) applying to an outer surface of the multicoat paint system by pneumatic spray application an extract of an aqueous basecoat material, substantially or entirely free from opaque pigments, which substantially corresponds or is identical to the aqueous basecoat material (A) or one of the aqueous basecoat materials (A) from which the basecoat (A) was produced, to form a resulting film (1), (2) flashing off and/or drying the resulting film (1) without curing it completely, (3) coating the resulting flashed off and/or dried film (2) by pneumatic spray application at a spraying pressure less than the pneumatic spray in step (1) with an aqueous basecoat material which substantially corresponds or is identical to the aqueous basecoat material (A) or one of the aqueous basecoat material (A) from which the basecoat (A) was produced, to form a resulting aqueous basecoat film (3), (4) flashing off and/or drying the resulting aqueous basecoat film (3) without curing it completely, (5) coating the resulting flashed off and/or dried aqueous basecoat film (4) with at least

one liquid clearcoat material to form at least one resulting clearcoat film, and (6) jointly curing the at least one resulting clearcoat film (5), the aqueous basecoat film (4) and the film (1), and, where present, any further uncured films that are present.

Mayer teaches a multicoat refinishing process in which a coating material is first applied to the prepared area of damage and to the adjacent regions of original finish. A metallic basecoat is applied to this first coating in such a way that the basecoat hides the area of damage and tapers off on the coating. A clearcoat is applied to the basecoat and, if appropriate, also to the adjacent regions of the original finish. In the process an aqueous metallic basecoat and an aqueous coating material containing a) 5 to 50% by weight, based on the total weight of the coating material, of at least one water-thinnable or water-dispersible film-forming material, b) 0 to 20% by weight, based on the total weight of the coating material, of at least one organic solvent c) conventional auxiliaries and additives, if appropriate, are applied to the prepared area of damage, the dry film thickness of this aqueous coating material being between 2 and 50  $\mu\text{m}$  in the region of the area of damage. (Mayer, abstract).

Applicants respectfully submit that the present claims are patentable over Mayer under 35 U.S.C. §102(b), at least because Mayer does not teach, explicitly or inherently, all the limitations of independent claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants further respectfully submit that the present claims are patentable over Mayer under 35 U.S.C. §103(a), at least because Mayer does not teach or suggest all the elements of independent claim 1, and there is no suggestion or motivation to modify Mayer to arrive at Applicants’ independent claim 1.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior

art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

As a preliminary manner, Applicants respectfully traverse the Examiner's statement that Applicants admitted that Mayer disclosed all limitations of claimed invention except that the known refinish process was unable to solve the existing problems. (2/19/2008 Office Action, page 4, second paragraph). Applicants respectfully submit that the foregoing is only an allegation brought forth by the Examiner, and is not supported by Applicants' Specification, since, as will be seen below, the present claims are indeed patentable over Mayer under 35 U.S.C. §102(b) and §103(a).

Independent claim 1 recites, among others, a process for overcoating a multicoat color and/or effect paint system. Independent claim 1 recites that the multicoat color and/or effect paint system comprises at least one color and/or effect basecoat (A) produced from at least one aqueous basecoat material (A) and at least one clearcoat (B) produced from at least one liquid clearcoat material (B). Independent claim 1 further recites that the process comprises (1) applying to an outer surface of the multicoat paint system by pneumatic spray application an extract of an aqueous basecoat material, substantially or entirely free from opaque pigments, which substantially corresponds or is identical to the aqueous basecoat material (A) or one of the aqueous basecoat materials (A) from which the basecoat (A) was produced, to form a resulting film (1). Independent claim 1 further recites that the process comprises (3) coating the resulting flashed off and/or dried film (2) by pneumatic spray application at a spraying pressure less than the pneumatic spray in step (1) with an aqueous basecoat material which substantially corresponds or is identical to the aqueous basecoat material (A) or one of the aqueous basecoat material (A) from which the basecoat (A) was produced, to form a resulting aqueous basecoat film (3).

That is, independent claim 1 recites that the aqueous basecoat material applied in (1) corresponds to (A), which is the basecoat material of the original finish being repaired, lacking opaque pigments. Further, independent claim 1 recites that the aqueous basecoat material applied in (3) corresponds to (A). Therefore, the basecoat (A) of the original finish which is being repaired, the basecoat (1) applied in the refinish, and the basecoat (3) applied in the refinish comprise the material of (A), with the proviso that the basecoat (1) lacks opaque pigments.

Mayer, however, does not teach or suggest that the basecoats applied in the refinish are of the same material as the basecoat applied in the original finish, and there is motivation in Mayer to modify Mayer in order to use the same material as the basecoat applied in the original finish.

On page 2, final paragraph, of the present Office Action, the Examiner cites Mayer's column 3, lines 12-23 as teaching that the coating composition may be a pigment-free extract of the aqueous refinish basecoat material. However, it is respectfully submitted that no such teaching is present in the Mayer at the above referenced section. Applicants respectfully submit that Mayer only teaches that the material used in the pigmented basecoat material of the refinish can be the same as the material used in the non-pigmented basecoat material of the refinish. (Mayer, column 14, lines 48-58). However, Mayer does not teach or suggest, or even allude to the basecoat in the refinish having the same material as the basecoat in the original finish, as is recited in independent claim 1.

The foregoing comments are further affirmed in Mayer's exemplary embodiments. In Mayer's examples, the original finish comprised a basecoat based on cellulose acetobutyrate. (Mayer, column 17, lines 16-17). However, Mayer's basecoats 1-5 used in the refinish do not contain any cellulose acetobutyrate. (Mayer, column 21, line 5, to column 22, line 8).

Therefore, in view of the above, Applicants respectfully assert that the present claims are patentable over Mayer under 35 U.S.C. §102(b) and §103(a) at least because Mayer does not teach all the elements of independent claim 1 explicitly or inherently,

does not suggest all the elements of independent claim 1, and there is no motivation to modify Mayer to arrive at Applicants' independent claim 1. Withdrawal of this rejection is respectfully requested.

2. **Rejection of claims 4-5, 13, and 15-16 under 35 U.S.C. §103(a) as being allegedly unpatentable over Mayer.**

Claims 4-5, 13, and 15-16 depend from and further limit independent claim 1, which is patentable over Mayer under 35 U.S.C. §103(a) as discussed above. Therefore, Applicants respectfully assert that claims 4-5, 13, and 15-16 are also patentable over Mayer under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

## CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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Monday, May 19, 2008

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